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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,087	01/30/2002	Benjamin C. Rivera	JPS 756.712	2441

152 7590 09/01/2005

CHERNOFF, VILHAUER, MCCLUNG & STENZEL
1600 ODS TOWER
601 SW SECOND AVENUE
PORTLAND, OR 97204-3157

EXAMINER

SHAKERI, HADI

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 09/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/066,087

Applicant(s)

RIVERA, BENJAMIN C.

Examiner

Hadi Shakeri

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16,26-28,32,37,38,43,44 and 46-68 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 16,26-28,32,37,38,43,44 and 46-68 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 031825&040405.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 46-60, 64, 65, 66 and 68 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 46 recites the limitation "outer margin" in line 2. There is insufficient antecedent basis for this limitation in the specification as originally filed. It is unclear what element is being claimed by "outer margin". Same deficiency applies to claims 65, 66 and 68.

Claim 64 recites the limitation "said second external channel" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

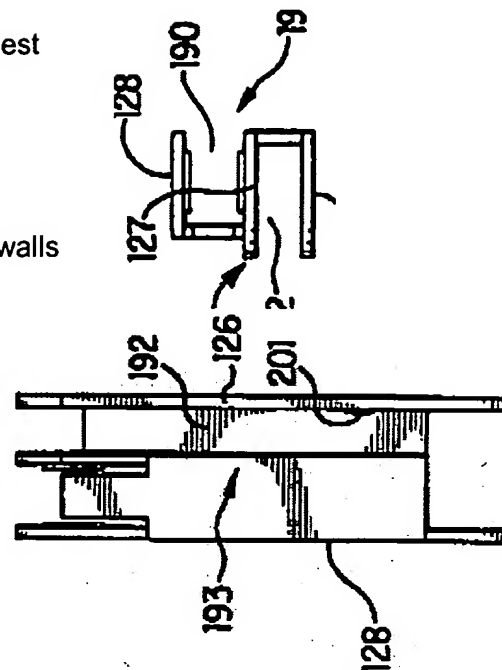
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 46-49, 52, 54, 61, 62, 65, 67 and 68 are rejected under 35 U.S.C. 102(e) as being anticipated by Taggart et al. (6,341,423).

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Taggart et al. discloses all of the limitations of claim 46 (as best understood), i.e., a handle for a folding tool comprising an elongate channel-shaped frame member having an outer margin with a first elongate side and first and second spaced-apart elongate channel walls integrally joined together by a channel floor to define a channel (192), said frame member further including an integral first external flange (defining the floor in channel 190) extending outwardly from at least a portion of said first channel wall in a first direction away from said channel, said first external flange including an integral first leaf spring, said first leaf spring forming a portion of said first elongate side of said outer margin.



Regarding claims 47-49, 52, 54, Taggart et al. meets the limitations, e.g., flange at an upper edge; independent spring (446).

Taggart et al. meets the limitations of claims 61, 62, 65, 67 and 68.

5. Claims 61, 63, 65 and 66 (as best understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Rivera (Des 405,676).

Rivera discloses all of the limitations of claim 61, i.e., a frame member comprising a channel having a pair of opposed walls joined by a floor and including a first external flange extending outwardly away from one of the channel walls away from the channel.



Regarding claims 63, 65 and 66, Rivera meets the limitations, e.g., second flange.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 50, 51, 53, 55-60, 63, 64, 66 and 16, 26-28, 32, 37, 38, 43, 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taggart et al..

Taggart et al. meets all the limitations of claim 50, as applied to claim 46 above, except for an integral second spring opposite the first on the flange (floor of 190). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include another integral spring on the floor, in adapting the tool for a particular tool bit and application, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Taggart et al. meets all the limitations of claims 51, as applied to claim 46 above, except for the location of the spring. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the floor accommodating the spring shorter, depending on a particular tool bit or intended use, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikes*, 86 USPQ 70.

Taggart et al. meets all the limitations of claim 53, as applied to claim 46 above, except for a leaf spring on the channel floor (i.e. floor of 192). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include an integral spring on the floor defining the channel (192), in adapting the tool for a particular tool bit and application, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

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Taggart et al. meets all the limitations of claim 55, as applied to claim 46 above, except for a second flange extending in an opposite direction. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the tool by including a third channel with wall (128) as the common wall, in adapting the tool to accommodate more tool bit and applications, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claims 56-60, 63, 64, 66, Taggart et al. as modified above and as applied in section 4, meets all the limitations.

Regarding claims 32, 37 and 38, Taggart et al. as modified and applied above meets all the limitations, i.e., first and second sidewalls (126, 126) joined by a floor (defining the floor in channel 192), first elongated flange (floor of channel 190) extending from the first sidewall (127) in a direction opposite the channel and including a leaf spring; tool bits (e.g., 284-289) mounted on a pivot pin (285), except for clearly disclosing the pivot pin to extend thru both channels, a modification well within the knowledge of one of ordinary skill in the art in reducing cost of manufacturing.

Regarding claims 16, 26-28, 43, and 44, Taggart et al. as modified and applied above, meets all the limitations.

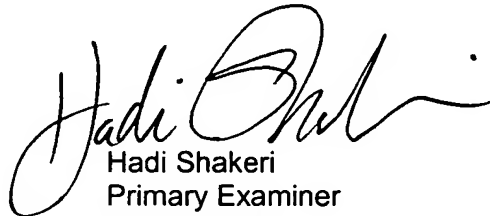
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hadi Shakeri whose telephone number is 571-272-4495. The examiner can normally be reached on Monday-Thursday.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Hadi Shakeri', with a stylized flourish at the end.

Hadi Shakeri
Primary Examiner
Art Unit 3723
August 29, 2005